

R E M A R K S

Claims 1-35 were pending in the present application.

Claims 1- 21 and 28 - 35 are now pending after cancellation of claims 22 - 27.

Claims 1, 28, 34 and 35 are independent.

Restriction Requirement and Provisional Election

In response to the Restriction requirement, Applicants provisionally elect with traverse

**Group I (claims 1 - 27 and 34) and
Species I (claim 6)**

Applicants request reconsideration of the restriction requirement, and withdrawal or modification of the requirement in light of the arguments below.

The Restriction Requirement

The Examiner has proposed that there are four species:

Species I - the embodiment where the information item is offered *before* receiving the payment. (Claim 6)

Species II - the embodiment where the information item is offered *after* receiving the payment.

Species III - the embodiment where the information item is offered *after* the dispensing of the product (claim 7)

Species IV - the embodiment where the information item is offered *as a package deal along with the product*. (claims 22 - 27)

The Examiner has also asserted that each of the four species to include subspecies A - X (i.e. 96 subspecies, which is 24 'subspecies' for each of the four species).

The Examiner asserts that there are four species of the invention, however, the Examiner has not specified which of the two proposed inventions (Group I and Group II) correspond to which of the four proposed species.

Claims 28 - 33 and 35 are apparatus claims directed to a vending system, and accordingly there is no ordering to the steps of offering, receiving payment, or dispensing a product in these apparatus claims. Accordingly, the species I, II and III cannot apply to claims 28 - 33 and 35 (group II), and Applicants assume the Examiner intends species I, II and III to be applicable to claims 1 - 27 and 34 (group I). If Applicants are mistaken, clarification is respectfully requested.

In addition, Species IV applies to both Group I and Group II in that both groups read on embodiments where the information item is offered as a package deal along with the product.

Finally, the Examiner has not indicated which claims correspond to any of the enumerated species or subspecies. In fact, several of the enumerated species and subspecies include limitations that are not recited by any pending claim (though various claims might cover those limitations along with others).

No showing that Groups I and II are distinctness or independent

The burden is on the examiner to provide reasonable examples that recite material differences in the process and products of the Groups. MPEP 806.05(e). The Examiner has not shown that the inventions of Groups I and II are either distinct or independent.

The only reasoning offered for the claims of group I and II being independent or distinct is that a "materially different apparatus" can practice the processes. Specifically, the Examiner proposes that "a completely audio activated or hands-free beverage dispenser" (presumably contrary to Group II) could be used instead to "practice the process of dispensing products and offering information items" (presumably Group I).

The Examiner has not shown why the claims of Group II are materially different from a "completely audio activated or hands-free beverage dispenser". In fact, there is no reason why the claims of Group II would not, in fact, **read on** a "completely audio activated or hands-free beverage dispenser". It appears that the pending claims have no relevance to "completely audio activated or hands-free beverage dispensers".

There are no reasons given for the creation of the four species

To the extent the Applicants understand the species proposed by the Examiner, they do not seem to correspond to separately claimed embodiments.

For example, the independent claims read on the various species proposed by the Examiner. In each of independent claims **1, 28, 34 and 35** there is no restriction on whether the information item is offered *before* receiving the payment (Species I) or *after* receiving the payment (Species II). Similarly, in each of independent claims **1, 28, 34 and 35** there is no restriction on whether the information item is offered *after* the dispensing of the product (Species III) or *before* the dispensing of the product.

Further, Species I is only recited in dependent claim 6, Species III is only recited in dependent claim 7, and no pending claim recites the limitations proposed in either of Species II or IV.

There is a generic claim

Independent claims **1, 28, 34 and 35** each read on all four species in that each of these claims would not preclude (and thus would cover) any of the four species proposed by the Examiner. Thus if any of these independent claims are allowable, all proposed species would be likewise allowable.

"More than one species of an invention ... may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form ..."

37 C.F.R. § 1.141(a).

Species not described with specificity

Each of the species is only tersely described as "the embodiment where...." followed by a particular limitation. No description provides any specificity to determine, for example, whether a claim would be generic to a species because it included "no material element additional

to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species". MPEP 806.04(d).

In addition, only proposed Species I and II are mutually exclusive. Various embodiments of the invention would also include permutations of two or more of the proposed species. Accordingly, the proposed species are not in fact true species to which the claims may be restricted. MPEP 806.04(f) ("Claims to be restricted to different species must be mutually exclusive."). However, since the specific limitations of Species II and IV are not recited in any claim, the point might be considered moot as to Species II and IV.

There is no authority to require election of a single disclosed 'subspecies'

The Office Action references ninety six 'subspecies' of the invention. Page 16 of the Office Action also asserts:

"Applicant is required under 35 U.S.C. 121 to elect a single disclosed **species in combination with a single subspecies** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims appears to be generic." (emphasis in original)

There is no authority to require restriction of subspecies. 35 U.S.C. § 121 is silent as to subspecies, and 37 C.F.R. §§ 1.141 - 1.146 refer only to inventions and species, not subspecies. If this requirement is maintained, Applicants request the authority for such a requirement.

Further, there is no indication whatsoever of why such subspecies should be subject to restriction.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.


Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$465.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date



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